

REMARKS:

Claims 1-12 are in the case and presented for consideration.

The Office has objected to claim 10 due to a typographical error. The error has been corrected and the claim has been amended accordingly in this regard.

Claims 1, 11, and 12 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite.

The claims have been drafted to avoid the Office's §112 rejection and are believed to be in proper form.

Claims 1 and 4-6 were rejected under 35 U.S.C. 103(a) as being obvious from U.S. Patent 6,314,499 to Kermani in view of U.S. Patent 6,704,819 to Chrysanthakopoulos.

Claims 2-3 and 9-12 were rejected under 35 U.S.C. 103(a) as being obvious from U.S. Patent 6,314,499 to Kermani in view of U.S. Patent 6,704,819 to Chrysanthakopoulos, and further in view of Mano (Computer System Architecture, 1982, Prentice-Hall).

Claim 7 was rejected under 35 U.S.C. 103(a) as being obvious from U.S. Patent 6,314,499 to Kermani in view of U.S. Patent 6,704,819 to Chrysanthakopoulos, and further in view of U.S. Patent 5,586,331 to Levenstein.

Claim 8 was rejected under 35 U.S.C. 103(a) as being obvious from U.S. Patent 6,314,499 to Kermani in view of U.S. Patent 6,704,819 to Chrysanthakopoulos, and further in view of Schwartz (Schwartz, Telecommunications Networks, Protocols, Modeling and Analysis, 1987, Addison-Wesley).

Applicant has rewritten claim 1, which now recites "a priority unit (19) directly connected to a multiplexer unit (18) via only a single active connection for applying control signals thereto." The cited prior art does not teach or suggest this limitation. Therefore, claim 1 is believed to be patentable.

Claims 2-10 depend from claim 1 and are believed to be patentable for at least the same reasons. In addition, claim 10 recites a limitation not taught or suggested by the prior art. Claim 10 has been rewritten and now recites "the first shadow register unit (3) and/or the at least one second shadow register unit (11) are connected to the associated processor (2, 10) via an interrupt (8, 16) initiated by respective status flags of said first and second shadow register units." None of the cited prior art teaches or suggest the claimed limitation. Accordingly, claim 10 is believed to be patentable for this reason as well.

In addition, applicant respectfully submits that claims 1 and 4-6 were improperly rejected based on prohibited hindsight. The Office explains that "The motivation to use the art of Chrysanthakopoulos with the art of Kermani would have been the benefit recited in Chrysanthakopoulos that the invention provides a technique for device arbitration that does not require any modifications to, nor participation by, the controlled device." Thus, the Office's logic is akin to the reasoning that the prior art is combinable because it works or is successful.

Applicant submits that "The consistent criterion for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that a claimed process should be carried out and would have reasonable likelihood of success, viewed in light of the prior art. Both the suggestion and the expectation of success must be found in the prior art, not in the applicant's disclosure." (emphasis added) *In re Dow Chemical Co.*, 837 F.2d 469, 5 U.S.P.Q. 1529 (Fed. Cir. 1988). The Office seems to be asserting that there would be an expectation of success, or similar argument (no modifications would be required and no participation would be required by the controlled device). But, the Office has not shown any suggestion by either of the references that the references should be combined. Thus, the rejection is simply based on the benefits which the examiner

gleans from applicant's disclosure.

Furthermore, applicant respectfully submits that claims 3 and 7-12 were improperly rejected based on prohibited hindsight.

Regarding claim 3, the Office states "The motivation to use the art of Mano with the art of Kermani would have been the benefit of improved system performance." Regarding claim 9, the Office states "the motivation to use the art of Mano with the art of Kermani and Chrysanthakopoulos would have been the benefit of having an integrated circuit available to perform the asynchronous communications." Claims 7-8 and 10-12 generally use the same type of improper logic. The "improved system performance" of claim 3 is recognizable from the present invention. Likewise, the advantage of an "integrated circuit to perform the asynchronous communications" is recognizable from the present invention. These benefits are not suggested in any way from the prior art references.

"When prior-art references require a selective combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself. Something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. It is impermissible to use the claims as a frame and the prior-art references as a mosaic to piece together a facsimile of the claimed invention." (emphasis added) *Uniroyal Inc. v. Rudkin-Wiloy Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988). "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." (emphasis added) *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). None of the references make the suggestion that the references should be combined. The benefits described by the Office are not actually suggested by the prior art. Rather, the

benefits described by the Office are either provided in the applicant's disclosure, or the examiner is using personal knowledge, which is equally improper. If the Office is using personal knowledge, then applicant respectfully requests an affidavit under 37 C.F.R. 1.104(d).

Accordingly, the application and claims are believed to be in condition for allowance, and favorable action is respectfully requested. No new matter has been added.

If any issues remain which may be resolved by telephonic communication, the Examiner is respectfully invited to contact the undersigned at the number below, if such will advance the application to allowance.

Favorable action is respectfully requested.

Respectfully submitted,



Yan Glickberg
Reg. No. 51,742
Attorney for Applicants
Tel: (845) 359-7700

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NOTARO & MICHALOS P.C.
100 Dutch Hill Road, Suite 110
Orangeburg, New York 10962-2100

Customer No. 21706

Mail all correspondence to:
Aaron Waxler, Registration No. 48,027
US PHILIPS CORPORATION
P.O. Box 3001
Briarcliff Manor, NY 10510-8001
Phone: (914) 333-9608
Fax: (914) 332-0615